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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212445
Party	Defendant Bullsone Co., Ltd.
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Attachments	BULLSONE OPPOSITION TO CONTINUED SUSPENSION.pdf(30918 bytes) Exhibit A www_worldipreview_com_article_when_brand_is_everything_prote.pdf(180277 bytes) Exhibit B www_ipstars_com_general_corp-1.pdf(134867 bytes) Exhibit C www_hcch_net_en_states_hcch_members_details1__sid_23.pdf(49996 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 79/106,767
For the mark Bull Device with Shield
Publication Date: April 24, 2013

RED BULL GMBH,)	Opposition No.: 91212445
)	Serial No.: 79/106,767
OPPOSER)	Trademark: Bull Device with Shield
)	
VS.)	
)	
)	
BULLSONE CO, LTD.)	
)	
APPLICANT)	
)	
_____)	

APPLICANT'S OPPOSITION TO OPPOSER'S REQUEST TO CONTINUE
SUSPENSION OF CASE AND
CROSS MOTION FOR TERMINATION OF OPPOSITION

Applicant, Bullsone Co., Ltd. ("Applicant") hereby opposes the request of Opposer Red Bull GmbH ("Opposer") to continue the suspension of this proceeding. Applicant also cross-moves for termination of the Opposition for lack of evidence and failure to prosecute.

This proceeding was filed over two and a half years ago, on September 9, 2013. At that time, Opposer offered no evidence in support of its Opposition, relying instead upon unsupported general allegations. Opposer were cited no marks of its own, offered no evidence or examples of similar products and so broadly described its rights so as to include any "design of a bull or bovine animal" thus rendering any assertions of confusion hopelessly unsustainable.

The Opposition appeared to be based on the odd assertion that "Beverages" are related to "vehicle lubricants" (see Notice of Opposition Cover - Goods/Services):

Beverages, energy drinks, sports drinks, soft drinks, as well as various other complementary and related products and services, including but not limited to lubricants, vehicles and vehicle accessories.

The Opposition also makes the wholly unsupported assertion that Opposer, Red Bull, sells cars, see Notice of Opposition at paragraph 1. "Opposer Red Bull is now and has for many years been engaged in the development, marketing, advertising, distribution and sales of various products and services including . . . vehicles . . ." Paragraph 1 also repeats the odd assertion that beverage and vehicle lubricant's are "complementary and related products."

OPPOSER'S UNSUPPORTED CLAIMS:

Opposer makes four claims: (i) Likelihood of Confusion; (ii) False Suggestion of a Connection; (iii) Dilution and (iv) Lack of Bona Fide Intent to Use. Each of the first three are based upon the same generalized and unsupported assertions:

¶11. Applicant's Opposed Mark so resembles Opposer Red Bull's RED BULL and Bull Logo Marks . . .

¶12. The goods . . . are identical or very similar to . . . Red Bull's products . . .

¶13. Simultaneous use . . . is likely to cause confusion, mistake or deception . . .

¶14. Use . . . is likely to lead to the mistaken belief that Applicant's products are sponsored by . . . Red Bull . . .

¶15. . . . Applicant's Opposed Mark is likely to cause confusion with Red Bull's . . . Marks . . .

17. Applicant's Opposed Mark is – and is intended to be – very similar to or a close approximation of the RED BULL and Bull Logo Marks . . .

18. . . . consumers are likely to recognize that the name and mark RED BULL points uniquely and unmistakably to Opposer . . .

20. . . . consumers would presume a connection between Applicant and Opposer . . .

21. Applicant's intent to use the Red Colored Bull Device with Shield mark for its products demonstrates that it is Applicant's intent to create an association with and reference to Red Bull.

22. . . . Applicant's Opposed Mark, falsely suggests a connection with Opposer, Red Bull . . .

24. . . . Applicant's Opposed Mark is – and is intended to be – very similar to or a close approximation of Opposer's RED BULL and Bull Logo Marks.

25. . . . RED BULL and Bull Logo Marks have become famous . . .

26. . . . RED BULL and Bull Logo Marks became famous . . . long prior to the May 20, 2011 . . .

27. . . . RED BULL and Bull Logo Marks are so distinctive in the United States that the public would associated them with Opposer even devoid of a trademark context or apart from the extensive goods and services offered by Opposer under the RED BULL and Bull Logo Marks.

28. . . . Applicant's Opposed Mark is likely to cause dilution . . .

29. . . . Applicant's Opposed Mark is likely to cause dilution by tarnishment . . .

The fourth claim is premised only upon information and belief:

32. On information and belief, Applicant did not, at the time of filing, have a bona fide intent to use the alleged Red Colored Bull with Shield mark on each and every good as recited in US Appln. No. 79/106,767.

Red Bull, as the Opposer, has the burden of coming forward with proof of the assertions in its Opposition. For example, Red Bull asserts that "goods are identical or very similar to" and "consumers would presume a connection." However, Red Bull has come forward with no evidence to support these assertions. Red Bull also asserts that "Applicant did not have a good

faith intent to use." Again, Red Bull has presented no evidence in support of this assertion. In sum, Red Bull has presented no evidence in support of any assertion in its Opposition.

Red Bull cannot maintain its premise, that vehicle lubricants and energy drinks are "complementary and related products" or are "goods that are identical or very similar." Nor can Red Bull possibly prove that Red Bull sells cars. Red Bull had and continues to have no basis for its opposition. Red Bull, instead of moving its own opposition forward, (which would typically be in the best interest of an Opposer seeking to legitimately protect its marks) has instead engaged in avoidance and delay tactics, refused to produce discovery and sought to delay its own trial evidence for close to two years.

TRIAL TESTIMONY:

Under the initial scheduling order Opposer's trial testimony was set to begin on July 19, 2014. (See Dkt. No. 2) However, as a result of the multiple motions for extensions and/or suspension of its own testimony period, filed by Opposer, no testimony has been taken, after nearly two years of delay. Opposer now requests that the current suspension be further continued to allow it to finally begin to attempt to determine if it can take the deposition of Jorge Casals, on written questions. This request should be denied. Jorge Casals is Red Bull's employee and could he have voluntarily presented testimony any time and any place of Red Bull's choosing. The delay is completely and intentionally of Red Bull's making.

In fact, Mr. Casals is not simply an employee, he is in-house IP counsel in charge of Red Bull's "aggressive trademark litigation strategy." (see Exhibit A from World Intellectual Property Review) It is nonsensical to believe that Mr. Casals does not know how to provide testimony in a Trademark proceeding. IN fact, Mr. Casals was named an "IP STAR" for his "exceptional

capacity for the strategic management and protection of his company's most valued intellectual property assets." (See Exhibit B)

Opposer has delayed this proceeding for two years, without proper cause and to the detriment of Applicant. Opposer now seeks further delay because it claims to be unable to obtain discovery from its own in-house IP counsel. There is no need for formalities and motion to compel testimony from a party's own witness. Red Bull's claim that "additional and further processing is required beyond the normal foreign deposition" makes no sense. Red Bull is not attempting to compel the deposition of an opposing party or a third party in a foreign country, thus no treaty compliance is necessary. The Witness, Mr. Casals, is Red Bull's own employee and it is presumed that he would be willing to provide testimony. If either of both of these excuses were correct, Red Bull could simply bring Mr. Casals to the United States and make him available for a deposition. In fact, when Red Bull first identified Mr. Casals as a trial witness, Applicant offered to travel to Austria to attend a deposition and stated that Applicant would not object to depositions in the US or in any European Hague Treaty Member country, by agreement.

UNREASONABLE AND AVOIDABLE DELAY:

Red Bull's Trial testimony Period was initially set for July/August 2014 (paper #2). The period was reset to Sept/Oct 2014 (paper #6) and then reset again to December 2014/January 2015 (paper # 8).

On December 1, 2014, Opposer filed its Pre-Trial disclosures prior to its Trial Testimony period set for December 2014 - Jan 2015. The Pre-Trial disclosures listed seven potential witnesses and listed no specific documents. Opposer Red Bull made no other effort to secure

any trial testimony nor to produce any trial documents. Red Bull did not notice or subpoena any depositions, Red Bull did not prepare any written interrogatory questions, nor indicate that any depositions were to be taken by written question. Red Bull instead filed to again move the trial testimony period which was then reset for May 18/June 16, 2015, paper #13.

On May 28, 2015, exactly ten days into its testimony period, the last day possible for noticing depositions by written questions under 37 CFR Section 2.124, Opposer for the first time served and filed its first notice of its intention to take Mr. Casals deposition in Austria on written questions. Red Bull did not produce any documents and did not notice any other depositions. On that same day, Red Bull asked for a 30 day extension of its trial testimony period, paper #15. Red Bull had clearly made no preparations and had undertaken no investigation as to the procedure for submission of written questions in Austria, as reflected in Red Bulls' statement in the notice of deposition:

PLEASE TAKE NOTICE that pursuant to Rule 31 of the Federal Rules of Civil Procedure, and 37 CFR Section 2.124, Opposer, Red Bull GmbH, will take the testimony deposition on written questions of Jorge Casals of Red Bull GmbH, Am Brunnen 1, Fuschl Am See, A-5330, AUSTRIA . The deposition will be taken on written questions in accordance with U.S. and Austrian law before an Austrian judge, a U.S. Consular officer, or an officer authorized to administer oaths for use in United States Patent and Trademark Office proceedings.

As Red Bull now contends, it is not possible to take the deposition of Mr. Casals in Austria by any of the proposed procedures. A simple check of the State Department confirms this at <http://travel.state.gov/content/travel/en/legal-considerations/judicial/country/austria.html>:

Taking Voluntary Depositions of Willing Witnesses

Austria is not a party to the Hague Convention on the Taking of Evidence Abroad in Civil and Commercial Matters. Although Article XVIII of the Friendship, Commerce and Consular Rights Treaty and Supplementary Agreement between the United States of America and Austria (1928, 1931) included specific provisions about the taking of depositions of by consular officers of nationals of their own country or permanent residents, Austrian authorities have informed the U.S. Department of State and the U.S.

Embassy in Vienna that voluntary depositions of willing witnesses may not be taken of Austrian citizens and that depositions of U.S. nationals or permanent residents can only be taken with specific permission of the Ministry of Foreign Affairs. Permission is not generally granted.

Thus, the notice of deposition was defective and Red Bull has run out of its testimony period without submission of any evidence. Red Bull should have investigated the procedures for procuring the testimony and brought Mr. Casals to the United States for his oral testimony.

The parties prepared written deposition questions and cross examination questions, and, on July 6, 2015, the Board suspended proceedings paper #17, to permit the questions to be submitted to Mr. Casals and the completion of Mr. Casals' deposition. However, the questions were never submitted to Mr. Casals

During the ensuing six month period, Red Bull made no attempt whatsoever to serve the written questions on Mr. Casals, made no attempt to get answers from its own highly sophisticated witness and made no attempt to determine the proper manner of procuring the desired testimony from Mr. Casals. Applicant's counsel has not received even so much as a copy of an e-mail to any entity reflecting any attempt at obtaining Mr. Casals testimony.

On January 25, 2016, the TTAB requested a status report on "the status of the completion of the depositions upon written questions. at paper #18. In response to the Board's January 25, 2016 Order, Opposer provided no evidence whatsoever of any effort to procure Mr. Casals' deposition on written questions in Austria. Instead, Opposer simply responded:

Austria is not a member of the Hague Convention¹ and additional and further processing is required beyond the normal foreign deposition. In accordance with Austrian law regarding taking a deposition for a United States proceeding, we are in the process of

¹ This statement is not correct. According to the website maintained by The Hague Conference on Private Internal Law – The World Organization for Cross-Border Co-operation in Civil and Commercial Matters, Austria has been a signatory to at least some portions of the Hague Convention since 1955. See printout from <https://www.hcch.net/en/states/hcch-members> attached at Exhibit C.

obtaining the additional supporting documents required by the Austrian government.² We have also been consulting with foreign counsel in Austria so that the request will comply with Austrian laws and be granted by the Austrian government.³

Opposer's response, which completely lacks any affirmative statements about any efforts made and lacks any evidence of any contact with Austria or any other authority, demonstrates that Red Bull made no effort to obtain the testimony. Opposer has not produced a single letter, email or legal document to demonstrate that has been making a good faith effort to procure Mr. Casals' deposition in a timely manner. Nor did it submit a declaration from its Austrian counsel attesting to the state of the law in Austria, the process in Austria and when and what efforts have been made to date. In fact, Opposer has not even identified its alleged Austrian counsel. Mr. Casals, the architect of Red Bull's aggressive Trademark protection strategy and a recognized IP STAR certainly knows how to give testimony. Infact, ". . . the company has a reputation for entering into cutting-edge cases in order to push the limits of its protection." (Exhibit A)

Red Bull is simply delaying the conclusion of this proceeding.

The continued suspension of this proceeding is extremely harmful to Applicant. While Opposer has many registrations already, Applicant has been held hostage by Opposer's repeated delays and suspension of this proceeding. Opposer should not be rewarded with further delay.

MOTION TO DISMISS PROCEEDINGS

Red Bull has no evidence to support the assertions of its Notice of Opposition. If Red Bull had such evidence of its production of vehicles, it customers confusion of motor oil and

² This statement is also inaccurate, as there is no "Austrian law regarding taking a deposition for a United States Proceeding."

³ This statement is also likely inaccurate, as no specifics nor evidence of this alleged communication has been presented, no foreign attorney has been identified and as confirmed by the US State Department, there are no such laws.

energy drinks, or the alleged delusion of RED BULL by Applicants use of BULLONE, then Red Bull should have and would have come forward sooner. Red Bull has not come forward with any evidence, has not attempted to present trial testimony or evidence and has instead attempted to accomplish the denial of registration, not through the presentation of evidence, but through delay.

Opposition proceedings are properly dismissed when an Opposer fails to present evidence.

CONCLUSION:

Accordingly, Applicant respectfully requests that Opposer's continued suspension request be denied and that the Board dismiss the opposition and close this matter for failure to timely prosecute on the part of Opposer.

For the foregoing reasons, Applicant respectfully requests that proceedings be dismissed.

Respectfully submitted,

STEIN IP, LLC

Date: March 7, 2016

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CERTIFICATE OF SERVICE

I hereby certify that on this 7th of March 2016, a true and correct copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S REQUEST TO CONTINUE SUSPENSION OF CASE was filed at the ESTTA and served upon the Counsel of the Opposer, by U.S. first-class mail, postage prepaid, at the following address, [with a courtesy copy served via email to MRG@Techmark.com:]

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Red Bull works hard to protect its brand wherever it may be threatened. Jorge Casals talks to WIPR about how the company manages this battle

Owing to its global market penetration and reach, the Red Bull brand is protected in 203 countries—nearly the entire world. And not just the name ‘Red Bull,’ but also the different elements of the can and brand design.

Red Bull rigorously takes action against infringing rival products based on its ‘Red Bull’, ‘Red’, ‘Bull’ and colour enforcement strategies, including its slogans. The company always seeks to invoke the wellknown trademark argument as any decision stating that the Red Bull Brand is well-known actually strengthens the brand and expands the scope of protection for future cases.

As a result, the company has a reputation for entering into cutting-edge cases in order to push the limits of its protection. At the heart of this strategy is the idea of legal sustainability. “This safeguards the brand value, because a brand that is not well protected cannot build up any value and/or gets quickly diluted,” Casals explains.

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Austria

**Member since**

15-VII-1955

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N.B. Please note that the above-mentioned National Organ has been designated in accordance with Article 7 of the Statute, "with a view to facilitating communication between the Members of the Conference and the Permanent Bureau".

Please click the links below for information on the authorities designated by this State in accordance with the Convention(s) by which it is bound:

Is bound by:

- Convention of 1 March 1954 on civil procedure [02]
- Convention of 24 October 1956 on the law applicable to maintenance obligations towards children [08]
- Convention of 15 April 1958 concerning the recognition and enforcement of decisions relating to maintenance obligations towards children [09]
- Convention of 5 October 1961 concerning the powers of authorities and the law applicable in respect of the protection of infants [10]
- Convention of 5 October 1961 on the Conflicts of Laws Relating to the Form of Testamentary Dispositions [11]
- Convention of 5 October 1961 Abolishing the Requirement of Legalisation for Foreign Public Documents [12]
- Convention of 4 May 1971 on the Law Applicable to Traffic Accidents [19]
- Convention of 25 October 1980 on the Civil Aspects of International Child Abduction [28]
- Convention of 29 May 1993 on Protection of Children and Co-operation in Respect of Intercountry Adoption [33]
- Convention of 19 October 1996 on Jurisdiction, Applicable Law, Recognition, Enforcement and Co-operation in Respect of Parental Responsibility and Measures for the Protection of Children [34]
- Convention of 13 January 2000 on the International Protection of Adults [35]
- Convention of 30 June 2005 on Choice of Court Agreements [37]
- Convention of 23 November 2007 on the International Recovery of Child Support and Other Forms of Family Maintenance [38]
- Protocol of 23 November 2007 on the Law Applicable to Maintenance Obligations [39]

Has signed:

- Convention of 15 April 1958 on the jurisdiction of the selected forum in the case of international sales of goods [05]
- Convention of 14 March 1978 on the Law Applicable to Matrimonial Property

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